

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shaher A. Ahmad
Serial No.: 10/645,739
Filing Date: August 21, 2003
Group Art Unit: 3733
Confirmation No.: 9156
Examiner: James L. Swiger III
Title: **BONE ANCHOR SYSTEM**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ELECTRONICALLY FILED
WITH THE USPTO ON
9-19-2008

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005. Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

In the prosecution of the present Application, the PTO's rejections and assertions contain clear errors of law. Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action transmitted on April 21, 2008 (the "Office Action") and the Advisory Action transmitted on August 8, 2008, to establish a *prima facie* rejection of Claims 1-12, 14-16, 30-32, 36-46, and 48-51 under either 35 U.S.C. §§ 102 or 103. Applicant respectfully requests reconsideration and favorable action in view of the following remarks.

Claim Rejections - 35 USC § 103

Claims 1-9, 30, 32, 36, and 38-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,417,692 to *Goble* et al. ("*Goble*") in view of U.S. Patent No. 5,338,197 to Kwan ("*Kwan*"). Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Goble* and *Kwan* and further in view of U.S. Patent No. 5,662,683 to Kay ("*Kay*"). Claims 11, 31 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Goble* and *Kwan* and further in view of U.S. Patent No. 6,333,971 to McCrory ("*McCrory*"). Applicant respectfully traverses these rejections for the reasons set forth below.

Claims 1, 30, and 36 are patentable because it would not be obvious to modify *Goble* to include the threaded passageway 60 of *Kwan*. A *prima facie* case of obviousness cannot be supported by a mere statement that the references relied upon teach all aspects of the claimed invention. MPEP § 2143.01(IV). The Office Action must provide an objective reason to combine the teachings of the references. *Id.* Here, the Office Action does not offer any objective reason to combine the references. Rather, it merely states that *Goble* lacks the threads, and *Kwan* discloses the threads. (Office Action p. 6). Such statement is not a clear articulation of the reason why the claimed invention would have been obvious. MPEP § 2142; *see also KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007).

Moreover, *Goble* teaches away from the modification proposed by the Examiner, and such modification would render *Goble* unsatisfactory for its intended purpose. MPEP § 2141.02(VI), 2143.01(V); *see also* pp. 17-18 of Applicant's Response to Final Office Action

filed June 23, 2008 ("Response to Office Action"). The Examiner has not opposed this argument--because he cannot. If *Goble* were modified to include the threaded passageway 60 of *Kwan*, in order to pull the broken bone end faces together into close fitting engagement (*Goble*, Col. 4, lines 33-35), one bone end would have to be rotated with respect to the other bone end. Rotation to join broken bone ends would be impossible--the bone ends must snap together. (*Goble*, Col. 1, line 62 - Col. 2, line 1). Accordingly, any modification of *Goble* to include the threads of *Kwan* would be improper because it would render *Goble* unsatisfactory for its intended purpose of maintaining bone ends together during healing. (*Goble*, Col. 4, lines 11-12). MPEP § 2143.01(V).

Therefore, as repeatedly argued by Applicant, *Goble* could not be modified to include a single, continuous recess thread configured to rotatably retain a threaded component. Therefore, the modification of *Goble* to include the threaded passageway 60 of *Kwan* is improper and cannot be used to obviate Claims 1, 30, and 36, which recite a single, continuous recess thread extending a majority of a length of a protrusion recess, the recess thread being configured to rotatably retain a threaded component at least partially within the protrusion recess. Applicant respectfully requests that the rejections of Claims 1, 30, and 36, and their respective dependent claims, if any, be withdrawn. Applicant further respectfully requests that the rejections of Claims 10, 11, 14, 31, and 37 be withdrawn because each rejection depends on the improper combination of *Goble* and *Kwan*, and the additional cited references cited do not cure this deficiency.

Claim Rejections - 35 USC § 102

Claims 12, 14-16 and 43-46 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,417,692 to *Goble et al.* ("*Goble*"). Applicant respectfully traverses these rejections for the reasons set forth below.

As previously argued by Applicant (and unaddressed by the Examiner), see Response to Office Action pp. 19-20, *Goble* does not disclose, teach, or suggest the structural elements of the driver recess of Claim 12. In particular, *Goble* does not disclose a driver recess configured to retain an insert. Rather, *Goble* teaches a turning tool 23 of *Goble* has a "cavity formed therein whose interior wall is sided, like that of the sided tool engaging section 22,

and is for making contact therewith to transfer tool 23 turning into member 11 or 12." (Col. 7, lines 38-41). Accordingly, *Goble* does not disclose, teach, or suggest a driver recess configured to retain an insert positioned at least partially within a threaded protrusion recess of the protrusion of the bone anchor to provide a friction fit between the driver and the bone anchor during insertion of the bone anchor. For at least this reason, Applicant respectfully contends that *Goble* does not disclose, teach, or suggest each of the limitations of Claim 12. Accordingly, Applicant respectfully requests that the rejections of Claim 12, and Claims 16 and 43-46, which depend therefrom, be withdrawn.

Claims 15 and 42 each include limitations directed to a distance between a driver edge and a rim that is approximately equal to a distance between a shoulder of a bone anchor and an end of a protrusion such that when the rim contacts the surface of the bone during insertion, the end of the protrusion will be approximately level with the surface of the bone. The Office Action does not even cite to a portion of *Goble* that discloses these elements. Applicant has repeatedly pointed out this deficiency, *see* Response to Office Action pp. 20-21, but it has not been addressed by the Examiner. Rather, the Office Action merely states, without any support, that "[t]his also has a distance that is approximately equal to the distance between the shoulder of the bone anchor and the end of the protrusion." (Office Action p. 2). Applicant respectfully disagrees. The sections of *Goble* that discuss the driver 23 do not disclose, teach, or suggest a distance between the driver edge and the rim of the driver that is approximately equal to a distance between the shoulder of the bone anchor and an end of the protrusion. (Col. 7, lines 34-41 and lines 56-61). For at least this reason, Applicant respectfully contends that *Goble* does not disclose, teach, or suggest each of the limitations of Claims 15 and 42, and therefore the rejection of Claims 15 and 42 should be withdrawn.

Goble also fails to disclose many other limitations of Applicant's claims. For example, as argued on page 21 and 22 of Applicant's Response to Office Action, *Goble* fails to disclose an insert being retained in the driver recess as recited by Claims 42 and 43. Accordingly, Applicant contends that Claims 42 and 43 are patentably distinguishable from *Goble* for at least these additional reasons.

Applicant further notes that Claims 48-51 do not appear to have been examined.

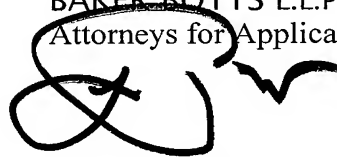
CONCLUSION

As the rejections of Claims 1-12, 14-16, 30-32, 36-46, and 48-51 contain clear deficiencies, Applicants respectfully request a finding of allowance of Claims 1-12, 14-16, 30-32, 36-46, and 48-51. If the PTO deems that an interview is appropriate, Applicants would appreciate the opportunity for such an interview.

Applicants submit a Request for One Month Extension. The Commissioner is hereby authorized to charge the amount of \$120.00 to satisfy the above calculated Extension of Time Fee, any additional fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant



Luke K. Pedersen
Reg. No. 45,003
(214) 953-6655

Date: 9/19/08

CORRESPONDENCE ADDRESS:

Customer No.: **05073**
Attorney Docket No. 073275.0146